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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,150	04/06/2000	Louis J Pinga	P006 P00252-US	9167

3017 7590 06/05/2003

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EXAMINER

SHIH, SALLY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/544,150

Applicant(s)

PINGA ET AL.

Examiner

Sally Shih

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This application has been reviewed. Original claims 1-30 are pending. The objections and rejections cited are as stated below:

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory matter.

Claims 1-30 show a series of steps which are grounded in the abstract idea of, for example, establishing, making, redeeming and transferring. The broadly recited steps do not recite sufficient computer structures that are within "technological arts". Therefore, they do not satisfy the statutory requirements of 35 U.S.C. 101. See *In re Toma*, 197 USPQ 852 (CCPA 1978).

The changes to fix this issue are relatively minor. For example, Claim 1 could be re-written so that the first step read --establishing a casino investment account for the benefit of a casino patron via a computer processor; and --.

However, Claims 1-30 as written are unacceptable under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 24-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Feidelson et al.

(United States Patent Number 6,345,261 B1).

Claim 24. Feidelson et al. discloses a method for implementing an expenditure tracking, reward, and investment program, said method comprising the steps of:

establishing an expenditure tracking account for the benefit of a consumer (Fig. 2-4 and column 14, lines 34-59),

making a deposit into said expenditure tracking account based on a percentage of the value of expenditures made by said consumer (Fig. 2-4 and column 14, lines 18-19);

associating said expenditure tracking account with a financial investment account of said consumer (Fig. 2-4 and column 14, lines 34-59);

redeeming said deposits from said expenditure tracking account; and transferring said redeemed deposits into said financial investment account (Fig. 2-4 and column 14, lines 34-59).

Claim 25. Feidelson et al. discloses the method of claim 24 wherein said step of making a deposit comprises the steps of:

registering at least one investment card of a consumer (Abstract and Fig. 2-4);

making expenditures using said at least one investment card (Fig. 2-4 and column 16, lines 6-15);

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identifying specific expenditures made using said at least one investment cards;
calculating a reimbursement based on said expenditures (Abstract and Fig. 2-4); and
redeeming said reimbursement for deposit on a monetary basis into said expenditure tracking account (Abstract and Fig. 2-4).

Claim 26. Feidelson et al. discloses the method of claim 24 wherein said step of making a deposit comprises the steps of:

tracking expenditures made by said consumer (Fig. 2-4 and column 9, lines 29-37),
identifying specific expenditures that are eligible for reimbursement (Fig. 2-4 and column 9, lines 38-42);
establishing a formula for calculating a reimbursement to be awarded to said consumer for making said identified specific expenditures (Fig. 2-4, column 9, lines 43-51 and column 14, lines 45-50);
calculating said reimbursement according to said formula based on said tracked expenditures (Fig. 2-4, column 9, lines 43-51 and column 14, lines 45-50); and
depositing said calculated reimbursement into said expenditure tracking account wherein said reimbursement is redeemable on a monetary basis by the consumer for transfer into said financial investment account (Fig. 2-4 and column 12, lines 12-36).

Claim 27. Feidelson et al. discloses the method of claim 26 wherein said step of tracking expenditures comprises the steps of.

registering at least one investment card of a consumer (Fig. 2-4 and column 14, lines 34-59),

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and making expenditures using said at least one investment cards (Fig. 2-4 and column 14, lines 34-59).

Claim 28. Feidelson et al. discloses the method of claim 24 wherein said step of making a deposit further comprises the step of depositing cash into said expenditure tracking account (Column 14, lines 22-25).

Claim 29. Feidelson et al. discloses the method of claim 24 wherein said financial investment account is operated and maintained by an independent financial institution (Column 8, lines 26-44).

Claim 30. Feidelson et al. discloses the method of claim 24 wherein said money transferred into said financial investment account is accrued on a tax deferred basis (Column 8, lines 14-25).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feidelson et al. (United States Patent Number 6,345,261 B1).

Claim 1: Feidelson et al. teach a method for implementing a patron betting, rating, and investment program, said method comprising the steps of

establishing a casino investment account for the benefit of a patron (Fig. 2-4 and column 7, lines 65-67);

making a deposit into said investment account (Fig. 2-4 and column 14, lines 23-25);

associating said casino investment account with a financial investment account of said patron (Fig. 2-4 and column 8, lines 34-41);

redeeming said deposits from said investment account (Fig. 2-4); and

transferring said redeemed deposits into said financial investment account (Fig. 2-4 and 52-54).

However, Feidelson et al. failed to explicitly specify an investment method and system use in connection with a casino. The examiner takes Official Notice that providing an investment account in connection with an entertainment service is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to include casino as one of participants of such invention because Fig. 4 has an entertainment category that listed various of entertainment services such as audio, book, music and an option key for more entertainment services. Casino service is categorized as an entertainment service. The use and advantages of the step of not listing all of the available services are well known.

Claims 2, 7, 8, 9 and 10: Feidelson et al. teach the method of claim 1 wherein said step of making a deposit comprises the step of depositing cash into said investment account (Fig. 2-4 and column 14, lines 23-25). However, Feidelson et al. failed to explicitly specify an investment method and system use in connection with a casino. The examiner takes Official Notice that providing an investment account in connection with an entertainment service is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to include casino as one of participants of such invention because Fig. 4 has an entertainment category that listed various of entertainment services such as audio, book, music and an option key for more entertainment services. Casino service is categorized as an entertainment service. The use and advantages of the step of not listing all of the available services are well known.

Claims 3, 11, 12 and 13: Feidelson et al. teach the method of claim 1 wherein said step of making a deposit comprises the steps of establishing a formula for

calculating investment rating points to be awarded to a patron during game play (Fig. 2-4 and column 7, lines 23-25);

calculating said investment rating points according to said formula during patron game play (Fig. 2-4 and column 7, lines 23-25); and

issuing said calculated investment rating points to said investment account wherein said investment rating points are redeemable on a monetary basis by the patron for transfer into said financial investment account (Fig. 2-4 and column 7, lines 30-34).

However, Feidelson et al. failed to explicitly specify having rating points to be awarded to a patron during game play. The examiner takes Official Notice that one would be able to award rating or loyalty points at any given time specified. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a feature to indicate the time period in which the rating or loyalty points are to be awarded because it takes certain amount of time to calculate and process the points. The use and advantages of this step are well known.

Claim 4: Feidelson et al. teach the method of claim 3 further comprising the step of issuing said patron an investment rating card that is associated with said investment account of said patron (Fig. 2-4 and column 8, lines 45-54). However, Feidelson et al. failed to explicitly specify issuing a hard copy card. The examiner takes Official Notice that one would be able to print out a hard copy of the investment account identifier on paper in the form of a card from the invention as described in Feidelson. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the capability of printing because hard copies are desirable for the purposes for record keeping. The use and advantages of this step are well known.

Claims 5, 14, 15 and 16: Feidelson et al. teach the method of claim 1 wherein said step of making a deposit comprises the steps of

establishing a casino system of investment betting chips (Fig. 3 & 4 and column 8, lines 55-65);

exchanging money for said investment betting chips (Fig. 3 & 4 and column 8, lines 55-65);

placing bets with said investment betting chips (Fig. 3 & 4 and column 8, lines 55-65);
and

redeeming said investment betting chips for deposit on a monetary basis into said casino investment account (Fig. 3 & 4 and column 8, lines 55-65).

However, Feidelson et al. failed to explicitly specify the use of betting chips. The examiner takes Official Notice that one would have the flexibility of choosing various medium such as paper documentations, cash, chips or even electronic currencies as the form of rebates for redeeming the loyalty points. It would have been obvious to one of ordinary skill in the art at the time of the invention to include various forms of currencies because cash alone is just not convenient as shown by use of credit cards, debit cards and electronic monies. The use and advantages of this step are well known.

Claims 6, 17, 18 and 19: Feidelson et al. teach the method of claim 1 wherein said step of making a deposit comprises the steps of

establishing a conventional rating account for the benefit of said patron (Fig. 2-4);

establishing a formula for calculating conventional rating points to be awarded to a patron during game play (Fig. 2-4);

calculating said conventional rating points according to said formula during patron game play (Fig. 2-4);

issuing said calculated conventional rating points to said conventional rating account (Fig. 2-4);

redeeming at least a portion of said conventional rating points on a predetermined monetary basis for transfer into said investment account (Fig. 2-4).

However, Feidelson et al. failed to explicitly specify an investment method and system use in connection with a casino. The examiner takes Official Notice that providing an investment account in connection with an entertainment service is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to include casino as one of participants of such invention because Fig. 4 has an entertainment category that listed various of entertainment services such as audio, book, music and an option key for more entertainment services. Casino service is categorized as an entertainment service. The use and advantages of the step of not listing all of the available services are well known.

Claims 20 and 22: Feidelson et al. teach the method of claim 1 wherein said investment account is operated and maintained by said casino (Fig. 3 and column 7, lines 16-42).

However, Feidelson et al. failed to explicitly specify casino as the merchant. The examiner takes Official Notice that one would consider a casino as a merchant. It would have been obvious to one of ordinary skill in the art at the time of the invention to include casino as one of the merchants as described of such invention because Fig. 4 has an entertainment category that listed various of entertainment services such as audio, book, music and an option key for more entertainment services. Casino service is categorized as an entertainment service. The use and advantages of the step of not listing all of the available services are well known.

Claims 21 and 23: Feidelson et al. teach the method of claim 1 wherein said investment account is operated and maintained by an independent financial institution (Column 8, lines 26-44).

However, Feidelson et al. failed to explicitly specify an investment method and system use in connection with a casino. The examiner takes Official Notice that providing an investment account in connection with an entertainment service is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to include casino as one of participants of such invention because Fig. 4 has an entertainment category that listed various of entertainment services such as audio, book, music and an option key for more entertainment services. Casino service is categorized as an entertainment service. The use and advantages of the step of not listing all of the available services are well known.

Conclusion


5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 4,774,663, USPN 5,970,480, USPN 5,991,736, USPN 6,178,408 B1, USPN 6,195,644 B1, USPN 6,278,983 B1, USPN 6,424,951 B1 and JP2000010778A are cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sally Shih whose telephone number is 703-305-8550. The examiner can normally be reached on Flexible.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7658 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

sys
June 2, 2003



HANI M. KAZIMI
PRIMARY EXAMINER